

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Corey *et al.*
Filing Date: April 30, 2001
Application Serial No.: 09/844,816
Title: TRYPSIN SUBSTRATE AND DIAGNOSTIC DEVICE,
AND METHOD OF USING SAME

Group: 1627
Examiner: Guo, Lynda T.

Atty. Docket No.: 038484-0067 (BYRK-19) (previously MSE #2609)

CERTIFICATE OF MAILING UNDER 37 C.F.R. 1.8

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November 4, 2002
Date


John Prince

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

In response to the Restriction Requirement dated October 2, 2002, in the above-identified patent application, Applicants elect to prosecute the claims of Group I, directed to a compound (claims 1-11). This election is made without traverse. Applicants reserve the right to prosecute the claims of Groups II-V in a later application.

The Restriction Requirement dated October 2, 2002 also requires the election of species for the three R groups. Applicants elect the arene sulfonyl species for the R¹ group, the nitro species for the R² group and the phenylpyrrole species and derivatives thereof for the R³ group. This election is made with traverse.

According to 37 C.F.R. 1.146, "the examiner may require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted if no claim to the genus is found to be allowable. However, if such application contains claims directed to more than a reasonable number of species, the examiner may require restriction of the claims to not more than a reasonable number of species before taking further action in the

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application." Applicants submit that it is not necessary to restrict the invention according to each of the three R groups in order to achieve a "reasonable number of species".

By electing only the arene sulfonyl species for the R¹ group, Applicants have restricted the scope of the search required by the U.S. Patent & Trademark Office to a "reasonable number of species". The species remaining following such an election do not have a separate classification, do not have a separate status in the art (or in the disclosure of the specification) and are not in different fields of search. *See*, MPEP § 808.02.

By further electing both the arene sulfonyl species for the R¹ group and the nitro species for the R² group, Applicants have restricted the scope of the required search to an even smaller "reasonable number of species". Applicants note that the specification in Example 4, discloses the synthesis of a compound where R² is arene sulfonyl (tosyl), *i.e.*, 3-(N α -tosyl-N_G-tosyl-L-argininyloxy)-5-phenylpyrrole. The synthesized compound disclosed in Example 4 is not so different from the other compounds disclosed in the specification as to require a species election.

Applicant should not be required to elect a species for all three of the R groups. Regarding the requirement to select a species from the R³ group, the scope of this group is already recited in independent claim 1 to be "aryl". Accordingly, Applicants have already restricted the scope of the required search to a "reasonable number of species" that should be readily searchable.

Moreover, in the specification, Applicants have disclosed the synthesis of compounds where R³ was an aryl. *See*, Example 2, synthesis of 3-(N α -tosyl-N_G-nitro-L-argininyloxy)indole, aryl group 3-hydroxy-5-phenylpyrrole, indoxyl (3-hydroxyindole); Example 3, synthesis of 4-(N α -tosyl-N_G-nitro-L-argininyloxy)-2-phenyl-5H-thiazole, aryl group 4-hydroxy-2-phenyl-5H-thiazol; and Example 5, synthesis of 7-(N α -tosyl-N_G-nitro-L-argininyloxy)-4-methylcoumarin, aryl group 7-hydroxy-4-methylcoumarine. These syntheses are in addition to the disclosure of the synthesis shown in Example 1, the synthesis of the compound 3-(N α -tosyl-N_G-nitro-L-argininyloxy)-5-phenylpyrrole. In the synthesis of all these compounds, a common intermediate was used, namely N α -*p*-toluenesulfonyl-N_G-nitro-L-argininyl chloride. Thus, all of compounds having an aryl R³ group are related to each other according to the same intermediate compounds

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(having R¹ and R² groups of arene sulfonyl and nitro, respectively) which are used to synthesize the final product. MPEP § 806.04(b). These species are not so independent as to require a species restriction requirement. Accordingly, Applicants should not be required to make a species election. Applicants request that the requirement for such a species election be withdrawn.

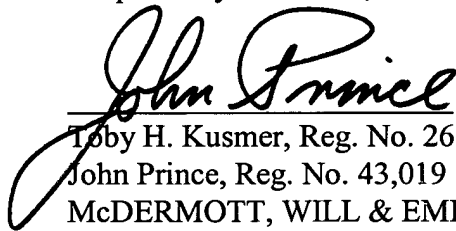
Applicants note that "Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim." MPEP § 806.04(h).

This Response is due November 4, 2002. 37 C.F.R. 1.7. No fee is believed to be due. Please charge any additional fees which may be due, or credit any overpayment, to Deposit Account Number 50-1133.

The Examiner is invited to telephone the undersigned attorney to discuss any aspect of this application or this response.

Respectfully submitted,

Date: November 4, 2002


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